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REMARKS

Claim 8 is amended herein. Support for the amendment to Claim 8 is found throughout the specification, for example, at page 12, second full paragraph. Accordingly, the amendment to Claim 8 does not add new matter.

New Claim 14 is added. New Claim 14 is supported throughout the specification, for example, in the claims as originally filed, in the specification at pages 3-4 and 12, and in the Examples, including Example 1, at pages 16-17. Accordingly, the new Claim 14 does not add new matter.

Upon entry of the amendments, Claims 8, 10-12 and 14 are pending. Applicants respectfully request entry of the amendments and reconsideration of the application in view of the following remarks.

Rejections Under 35 U.S.C. §102(b)

AU 9640808A

Claims 8 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by Australian publication AU 9640808A.

The Office Action states that AU 9640808A discloses a polyester film that can be coated on both sides with an adhesive that contains pyrrolidinium rings.

As Applicants have previously stated, AU 9640808A teaches at page 11, lines 12-14, that without exception, the disclosed adhesive polyester film always has a magnetic recording layer and/or a printing ink layer, which are not transparent. All Examples and Comparative Examples of AU 9640808A describe non-transparent adhesive polyester films containing both ink and a magnetic coating (except Comparative Examples 2 and 3 which were too unstable to be prepared). AU 9640808A teaches that a white pigment in the polyester film is preferred, and the reference never mentions embodiments in which the polyester film completely lacks any pigment.

In reply to Applicants' statements, the Office Action states:

Applicant argues that AU 9640808A reference teaches that, without exception, the disclosed adhesive polyester film always has a magnetic recording layer and/or a printed ink layer, which are not transparent. This is not found to be convincing because, as applicant correctly noted, the AU'808 reference teaches that the

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polyester film has a magnetic layer and/or printed ink layer. However, applicant should note that the magnetic layer and/or the printed ink layer does not cover the entire surface. Hence, the adhesive polyester film is not "not transparent" as alleged because, for example the areas not covered by the magnetic layer and/or the printed layer would not be not transparent. *Office Action* at page 5 (italics in original, underline added).

The Office Action points to no portion of AU 9640808A to support the assertion that AU 9640808A discloses "the magnetic layer and/or the printed ink layer does not cover the entire surface." Applicants presume the Office Action is referring to AU 9640808A at page 11, lines 15-31, which states:

Therefore, according to the present invention, there are provided (1) a polyester film having an information function, in which an adhesive coating film is present on one side of an aromatic polyester film (A) and at least one of a magnetic recording layer and a printing ink layer is present on at least part of the surface of the adhesive coating film, (2) a polyester film having an information function, in which an adhesive coating film is present on both sides of an aromatic polyester film (A) and at least one of a magnetic recording layer and a printing ink layer is present on at least part of the surface of one of the adhesive coating films, and (3) a polyester film having an information function, in which an adhesive coating film is present on both sides of an aromatic polyester film (A), a magnetic recording layer is mainly present on one of the adhesive coating films, and a printing ink layer is mainly present on the other adhesive coating film.

Thus, in contrast to the assertion in the Office Action, AU 9640808A does not disclose that "the magnetic layer and/or the printed ink layer does not cover the entire surface." AU 9640808A discloses that the magnetic layer and/or the printed ink layer covers at least part of the entire surface. All Examples and Comparative Examples in AU 9640808A are consistent with this teaching because they all disclose a magnetic layer and/or the printed ink layer covering the entire surface. There is no disclosure in AU 9640808A that a "magnetic layer and/or the printed ink layer does not cover the entire surface." While it may be possible, or even probable, that embodiments could exist where a magnetic layer and/or the printed ink layer does not cover the entire surface, such possibility or probability is insufficient: "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a

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certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted, emphasis added). There is no disclosure in AU 9640808A of a “magnetic layer and/or the printed ink layer [that] does not cover the entire surface.” To assert that AU 9640808A anticipates the claims without relying only on that which is necessarily present in the disclosure of AU 9640808A is inconsistent with the dictates of the Federal Circuit.

As Applicants also have previously stated, all of the Examples and Comparative Examples have polyesters comprising 10% by weight of titanium oxide. AU 9640808A discloses only pigment-containing polyesters, and never mentions that the polyester can be transparent. For example, at page 1, lines 7-10 the reference discusses, “Aromatic polyester films, particularly aromatic polyester films containing white pigment such as titanium oxide, are used in a wide variety of fields such as magnetic cards, printing materials and the like.” At page 4, lines 4-5, the reference teaches “In the present invention, the aromatic polyester preferably contain [sic] white pigment.” There is a complete absence of any teaching that any embodiment of the polyester used in AU 9640808A would be transparent. Thus, there is no disclosure, express or inherent, in which the polyester film used in AU 9640808A comprises no pigment.

In reply to Applicants’ statements, the Office Action states:

Responding to applicant’s arguments that AU’808A indicates that a *white pigment in the polyester film is preferred*, applicant is informed that said presence of a white pigment is directed to a preferred embodiment. Further, the presence of the white pigment does not render the film non-transparent as alleged. The presence of a white pigment can reduce the transparency.

Applicant’s argument that the probability/possibility of the presence of the white pigment in the polyester film of AU’808A makes the film non-transparent is not deemed to be convincing because, as explained hereinabove, the presence of said pigment can reduce the transparency but make the film non-transparent as opined by the applicant. *Office Action* at pages 5-6 (italics in original, underline added).

The Office Action appears to take the position that a film containing pigment, while having reduced transparency, would not be non-transparent. Applicants submit that such a use of the term “transparent” is inconsistent with the ordinary meaning of “transparent” as exemplified in attached Exhibit 1 from Random House Unabridged Dictionary, which defines “transparent” as “having the property of transmitting rays of light through its substance so that bodies situated

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beyond or behind can be distinctly seen.” A film containing pigment would absorb light so that bodies situated beyond or behind would be obscured; a film containing pigment would not be “transparent” in accordance with the ordinary meaning of the term. Thus, a film containing pigment would not anticipate the claims. Since there is no disclosure in which the film used in AU 9640808A comprises no pigment, there is no disclosure in the reference of a transparent film. That there is a possibility of a film in AU 9640808A not containing pigment is insufficient to assert that the film would inherently be transparent.

Moreover, the present rejection necessarily depends on the combination of possibilities discussed above. That is, the PTO’s assertion of inherency depends on an embodiment in the AU 9640808A in which magnetic recording layer and/or a printing ink layer is present on only a part of the surface (a mere possibility), and the adhesive polyester film lacks pigment (a mere possibility). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). Nothing in AU 9640808A provides anything beyond a mere possibility that the adhesive polyester film is transparent. Accordingly, nothing in AU 9640808A can be used to establish the inherency of the transparency of the adhesive polyester film of AU 9640808A.

In view of the above, Applicants respectfully request that the anticipation rejection of Claims 8 and 12 be removed.

New Claim 14

New Claims 14 is drawn to a transparent surface protective film where, *inter alia*, the entirety of the surface protective film is transparent. As is clear from the discussion above, AU 9640808A teaches at page 11, lines 12-14, that without exception, the disclosed adhesive polyester film always has a magnetic recording layer and/or a printing ink layer on at least part of the film

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of AU 9640808A. These layers are not transparent. Accordingly, the disclosure of AU 9640808A cannot anticipate new Claim 14.

Malhotra

Claims 8 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by Malhotra (U.S. Pat. No. 5,534,374).

The PTO has previously stated that Malhotra discloses a transparent polyester substrate, and discloses an antistatic pyrrolidinium ring structure having radical R that can include carbon atom of 20 or 30, which is taken to be the polymer chain.

Claim 8, as amended, recites, *inter alia*, that the antistatic layer comprises polymers having pyrrolidinium rings as multiple repeating units in main chains thereof. Malhotra does not disclose a polymer that has a pyrrolidinium rings as multiple repeating units in its main chain. Accordingly, Malhotra cannot anticipate Claim 8 or any claim dependent therefrom.

In addition, Applicants maintain that Malhotra's teaching of a pyrrolidine containing a radical group of, e.g., 20 or 30 carbons is not a teaching of a pyrrolidine in the main chain of a polymer.

The Office Action has responded to Applicants' previous remarks in this regard by stating:

Regarding applicant's argument for Malhotra, applicant is informed that, contrary to the allegation, applicant has failed to show that Malhotra does not comprise a polymer of 20-30 carbon atoms with repeating units, secondly, the claims does [not] recite that the main contains a number of repeating pyrrolidinium rings, and said limitation cannot be read thereinto for the purpose of avoiding the applied prior art.

Thus, the Office Action assigns to Applicant the burden of proving what is not inherently disclosed in Malhotra. This is inconsistent with USPTO policy. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original); see also *M.P.E.P* §2112. The burden is on the USPTO to

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demonstrate that which is asserted as being inherent. The Office Action fails to carry that burden.

The Office Action provides no basis in fact that Malhotra discloses a pyrrolidinium ring structure having a radical R which can include carbon atom of 20 or 30 which is necessarily a polymer chain. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). Nothing on the record would support an assertion that Malhotra discloses a pyrrolidinium ring structure having a radical R which can include carbon atom of 20 or 30 which is necessarily a polymer chain. Absent such support, Malhotra cannot inherently anticipate the claims.

In view of the above, Applicants respectfully request that the anticipation rejection of Claims 8 and 12 be removed.

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CONCLUSION

In light of the Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.


Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 8, 2007

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Exhibit 1

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Library of Congress Cataloging-in-Publication Data
Random House unabridged dictionary.
(Random House dictionaries)

1. English language--Dictionaries. I. Flexner,
Stuart Berg. II. Series.

PE1625.R3 1987 423 93-84591

ISBN 0-679-42917-4; 0-679-42441-5 (with CD-ROM)

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